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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/159,068 09/23/98 MARATOS-FLIER

E 10276/014002

EXAMINER

SAOUD, C

ART UNIT	PAPER NUMBER
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1646

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DATE MAILED:

03/06/00

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HM22/0306

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trad marks**

<b>Office Action Summary</b>	Application No. 09/159,068	Applicant(s) <b>MARATOS-FLIER</b>
	Examiner Christine Saoud	Group Art Unit 1646

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-29 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7 and 13, drawn to a method of promoting eating appetite, or the gain or maintenance of weight, classified in class 514, subclass 9, for example.
  - II. Claims 8-12, drawn to a method of inhibiting eating appetite, or the gain of weight, classified in class 514, subclass 2, for example.
  - III. Claims 14-17, drawn to a method of evaluating treatment by administering the treatment to a melanocyte based assay system, followed by a second system and determining effects on both systems, classified in class 435, subclass 4, for example.
  - IV. Claims 18-20 and 23, drawn to a method of evaluating treatment for its effect on reporter gene expression, MCH RNA, or protein levels, classified in class 435, subclass 6, for example.
  - V. Claims 21-22, drawn to a method of evaluating an agent for its effect on eating behavior, appetite, or the maintenance of weight by studying binding of MCH to a receptor with or without a substrate, classified in class 435, subclass 7.1, for example.
  - VI. Claim 24, drawn to a method of evaluating an agent for the ability to bind an MCH polypeptide, by evaluating the ability of the agent to form a complex with the polypeptide , classified in class 435, subclass 7.1, for example.
  - VII. Claim 25, drawn to a method of evaluating an agent for the ability to modulate an interaction of an MCH polypeptide with a second polypeptide, and detecting the interaction, classified in class 435, subclass 7.1, for example.
  - VIII. Claim 26, drawn to a method of evaluating an effect of a treatment, using an organism or cell carrying a transgene or misexpressed gene, and evaluating the effect on MCH metabolism, classified in class 424, subclass 9.2. for example.

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- IX. Claim 27, drawn to a method of determining risk by using genetic testing, classified in class 435, subclass 6, for example.
- X. Claim 28, drawn to a method involving in vivo testing, classified in class 424, subclass 9.1, for example.
- XI. Claim 29, drawn to a transgenic cell or non-human mammal, classified in class 800, subclass 240.1, for example.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions VIII and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process, such as in studying the regulation of color change in fish (see specification at page 2, lines 1-3).

4. Inventions I-X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to materially different methods which all have different method steps, goals, and/or starting materials.

5. Inventions (I-VII and IX-X) and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

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instant case the different inventions of methods and transgenic cell or non-human animal are not disclosed as capable of use together, and are therefore, unrelated.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the search required for each group is not coextensive with the other groups, restriction for examination purposes as indicated is proper.

7. This application contains claims directed to the following patentably distinct species of the claimed invention:

(i) Species A, claims 18-21, drawn to a method of evaluating treatment for its effect on eating behavior in vitro, class 435, subclass 240.2. Species B, claims 18-21, drawn to a method of evaluating treatment for its effect on eating behavior in vivo, class 424, subclass 9.2.

(ii) Species A, claims 26, drawn to a method of evaluating an effect of a treatment, using an organism carrying a transgene or misexpressed gene, class 435, subclass 4. Species B, claim 26, drawn to a method of evaluating an effect of a treatment, using a cell carrying a transgene or misexpressed gene, class 424, subclass 9.2.

(iii) Species A, claim 29, drawn to a transgenic cell, class 435, subclass 240.1. Species B, drawn to a transgenic animal, class 800, subclass 2.

If Applicant elects one of groups IV, V, VIII, or XI, Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims

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shall be restricted if no generic claim is finally held to be allowable. Currently, claims 18-21, 26 and 29 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

March 3, 2000

**CHRISTINE SAoud  
PATENT EXAMINER**  
*Christine Saoud*



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

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